

REMARKS

The Examiner has set a shortened statutory period for response to this communication to expire one (1) month from the mailing date of the communication, making Applicants' response due by December 5, 2007.

In the Office Communication, claims 1-5 were pending. The Examiner has taken the position that the application claims two independent and distinct inventions, which have been grouped as follows:

- I. Claims 1-4 drawn to a process for preparing a compound classified in class 558.
- II. Claim 5 drawn to a compound of formula (II) classified in class 558 and subclass 303.

The Examiner argues that Groups I and II "do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features that define a contribution over the prior art." The Examiner goes on to state "[t]he instantly claimed invention contains a dimethyl cyclo-propane carboxylic acid group as the technical features is common in all invention groups. However, this technical feature was known in the art prior to the filing of the instant application".

Applicants respectfully disagree with the Examiner's position. The Examiner has cited to PCT Rules 13.1 and 13.2 to support the restriction requirement yet, during the international phase, the International Preliminary Examination Report (IPER) clearly acknowledged that the claims form a single general concept under the rules. Perhaps more importantly, though, the Examiner seems to misstate the rules, which has led to their misapplication in this case. Here, the Examiner argues that the claims lack a single general concept because they lack the same or corresponding special technical features that define a contribution over the prior art. However, PCT Rules 13.1 and 13.2 do not state that a lack of unity is found whenever there is a lack of the same or corresponding special technical features that define a contribution over the prior art. Rather, the rules provide:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1

shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

MPEP § 1850.

In other words, the claims in an application are linked so as to form a single general inventive concept where there is one or more of the same or corresponding technical features among the group of inventions.

Here, both the process and compound claims relate to α -cyano-3-phenoxybenzyl (Z)-(1R,3R)-3-(2-chloro-3,3,3-trifluoro-1-propenyl)-2,2-dimethylcyclopropanecarboxylate. This is not disclosed in US 3,835,176 cited by the Examiner. Accordingly, claims 1-4 and claim 5 have a special technical feature in common and therefore, by the rules, must be considered as forming a single general inventive concept under PCT Rule 13.1. As such, the requirement of unity of invention is fulfilled.

In addition to the foregoing, Applicants further assert that the Examiner has failed to provide reasons why examining each of the five (5) claims as a single application will create a serious burden on the PTO. Indeed, the compound prepared in claims 1-4 and the compound claimed in claim 5 have the same classification. If the compounds have the same classification, how could the search create a serious burden on the PTO? Applicants submit that the Examiner would employ the same field of search to examine these claims because it would appear that a reference that is relevant to one group would also be relevant to the other. MPEP Section 802.02 provides that when the claimed inventions have the same classification, the same field of search, and there exists no clear indication of separate status in the art, the examiner cannot support a contention of serious burden on the PTO. Accordingly, dividing up the claims as the Examiner is requiring here is improper.

Pursuant to 35 U.S.C. § 121, the Examiner has required that Applicants elect between the inventions. Accordingly, Applicants elect to proceed with Invention I, claims 1-12 and 17.

Applicants reserve the right to file one or more divisional applications directed to the subject matter of claims that are ultimately cancelled as a result of the Examiner's requirement.

Applicants believe that this communication is fully responsive to the Office Communication and that no new fees are due. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

USPTO Customer No. 26748
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409
(336) 632-6049

/Rebecca A. Howard/
Rebecca A. Howard
Attorney for Applicants
Reg. No. 51,724

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